Supreme Court, U.S.
FILED
DEC 28 1998
OFFICE OF THE CLERK

No. 98-856

IN THE
Supreme Court of the United States
OCTOBER TERM, 1998

GILBERT P. HYATT,
Petitioner,

v.

GARY W. BOONE,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

Of Counsel:
JAY M. CANTOR
Suite 300 East
1100 New York Avenue, N.W.
Washington, D.C. 20005-3955
(202) 414-4048

LOUIS TOUTON *
JONES, DAY, REAVIS & POGUE
555 West Fifth Street
Los Angeles, CA 90013-1025
(213) 489-3939

GREGORY A. CASTANIAS
JONES, DAY, REAVIS & POGUE
1450 G Street, N.W.
Washington, D.C. 20005
(202) 879-3939

* Counsel of Record

Counsel for Respondent

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

QUESTION PRESENTED

The question presented in the petition was not argued or decided below. It is most accurately stated as follows:

Whether 35 U.S.C. § 112, ¶ 1, which by its terms requires a patent applicant to provide a written description of both "the invention," as well as "the manner and process of making and using it" requires a written description both (i) to show that the applicant was in possession of the invention, and (ii) to enable a skilled artisan to make and use the invention.

PARTIES TO THE PROCEEDINGS

All parties in the court and agency below and here are listed in the caption. For the Court's information, the real party in interest for respondent is Texas Instruments Incorporated, which is the assignee of Boone's application-in-interference.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
PARTIES TO THE PROCEEDINGS	ii
TABLE OF AUTHORITIES	iv
STATEMENT	2
1. The Origin of This Case	2
2. The Statutory Framework	6
3. The 1988 Federal Circuit Decision	7
4. The Board's Decision in the Present Case	9
5. The Federal Circuit's Decision Below	10
REASONS FOR DENYING THE WRIT	12
I. THE QUESTION PRESENTED BY PETITIONER WAS NOT RAISED OR RULED UPON BELOW	13
II. THE DECISION BELOW CONFLICTS WITH NO OTHER CIRCUIT OR SUPREME COURT AUTHORITY AND WAS CORRECT	16
A. No Conflict In Authority Has Been Shown Or Even Alleged	16
B. The Decision Below Was Correct	17
III. THIS CASE PRESENTS NO ISSUE WORTHY OF THIS COURT'S CONSIDERATION	23
CONCLUSION	26

TABLE OF AUTHORITIES

CASES

	Page
Adikes v. S.H. Kress & Co., 398 U.S. 144 (1970)	15
Albemarle Paper Co. v. Moody, 422 U.S. 405 (1975)	23
In re Alton, 76 F.3d 1168 (Fed. Cir. 1996)	7, 17, 18
Amgen Inc. v. Genetics Institute, Inc., 98 F.3d 1328 (Fed. Cir. 1996)	25
In re Barker, 559 F.2d 588 (CCPA 1977), *cert. denied*, 434 U.S. 1064 (1978)	21
Bocciarelli v. Huffman, 232 F.2d 647 (CCPA 1956)	18
Brand v. Thomas, 96 F.2d 301 (CCPA 1938)	22
Dart Industries, Inc. v. E.I. du Pont de Nemours & Co., 489 F.2d 1359 (7th Cir. 1973), *cert. denied*, 417 U.S. 933 (1974)	17
Delta Airlines v. August, 450 U.S. 346 (1981)	14
In re DiLeone, 436 F.2d 1404 (CCPA 1971)	17
In re Driscoll, 562 F.2d 1245 (CCPA 1977)	24
In re Edwards, 568 F.2d 1349 (CCPA 1978)	11
Evans v. Eaton, 20 U.S. (7 Wheat.) 356 (1822)	19, 20
First Options of Chicago, Inc. v. Kaplan, 514 U.S. 938 (1995)	24
Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987)	19
Jepson v. Coleman, 314 F.2d 533 (CCPA 1963)	11, 25
Lehman v. Zurko, 119 S. Ct. 401 (1998)	16, 24
Lindahl v. OPM, 470 U.S. 768 (1985)	23
Lockwood v. American Airlines, 107 F.3d 1565 (Fed. Cir. 1997)	7, 11, 14, 23
Markman v. Westview Instruments Inc., 517 U.S. 370 (1996)	15, 17
Martin v. Mayer, 823 F.2d 500 (Fed. Cir. 1987)	11, 23
Mobil Oil Corp. v. FPC, 417 U.S. 283 (1974)	16
Pfaff v. Wells Electronics, Inc., 119 S. Ct. 304 (1998)	17, 21, 22
In re Ruschig, 379 F.2d 990 (CCPA 1967)	17
Sisson v. Ruby, 497 U.S. 358 (1990)	15
In re Smith, 481 F.2d 910 (CCPA 1973)	17, 18
Smith v. Allwright, 321 U.S. 649 (1944)	24

TABLE OF AUTHORITIES—Continued

	Page
Timely Products Corp. v. Arron, 523 F.2d 288 (2d Cir. 1975)	17
United States v. Menasche, 348 U.S. 528 (1955)	21
United States v. Mendenhall, 446 U.S. 544 (1980)	15
Universal Camera Corp. v. NLRB, 340 U.S. 474 (1951)	16
Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991)	*passim*
Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 117 S. Ct. 1040 (1997)	16
In re Wertheim, 541 F.2d 257 (CCPA 1976)	12, 15, 24
In re Wilder, 736 F.2d 1516 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 1209 (1985)	17
In re Wright, 866 F.2d 422 (Fed. Cir. 1989)	19
Youakim v. Miller, 425 U.S. 231 (1976)	15
STATUTES	
35 U.S.C. § 102(b)	21
35 U.S.C. § 112	*passim*
35 U.S.C.A. § 112, Historical Notes (West 1984)	23
35 U.S.C. § 120	3, 6
35 U.S.C.A. § 120, Historical Notes (West Supp. 1998)	23
Patent Act of 1793, § 3, 1 Stat. 318	19
LEGISLATIVE HISTORY	
S. Rep. No. 275, 97th Cong., 1st Sess. 3 (1981)	15

IN THE

Supreme Court of the United States

OCTOBER TERM, 1998

No. 98-856

GILBERT P. HYATT,

Petitioner,

v.

GARY W. BOONE,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

---

RESPONDENT'S BRIEF IN OPPOSITION

This case involved the factbound question of who first invented a "computer on a chip," a device incorporating all the essential parts of a computer on a single integrated circuit chip. Petitioner Hyatt alleged he was the first inventor by virtue of a patent application he filed on December 28, 1970. Respondent Boone contended, the Board of Patent Appeals and Interferences ("Board") found, and the Court of Appeals for the Federal Circuit affirmed, that Boone, and not Hyatt, was the first inventor based on Boone's possession of the invention as of July 19, 1971. In reaching this finding, the Board and the Federal Circuit determined that Hyatt did not describe the invention now at issue in his 1970 patent application, but instead first described it in an application he filed in 1977 with added language.

This dispute was resolved in Boone's favor by the Board based upon its evaluation of a voluminous record of patent

applications, prosecution histories, documentary evidence and testimony. The Court of Appeals affirmed the Board's findings as not clearly erroneous, applying the consistent, logical, and statutorily grounded precedent of both the Federal Circuit and its predecessor, the United States Court of Customs and Patent Appeals ("CCPA"). Hyatt's petition seeks review of the Federal Circuit's decision upon a legal basis he never asserted before the Federal Circuit or at any other stage of this proceeding and which has never been addressed or ruled upon by any tribunal in this case. There is no basis for this Court's review.

STATEMENT

The background of this case is as follows:

1. *The Origin of This Case*

This case arose out of a patent interference proceeding in the Patent and Trademark Office ("PTO") to determine priority of invention of the computer on a chip. Such devices, commonly known as single-chip microcontrollers, execute computer programs permanently stored on the chip to duplicate functions that previously would have required custom-designed, hard-wired electronic logic circuits. The invention at issue is set forth in claim 29 of U.S. Patent No. 4,942,516 ("the '516 patent") issued to Hyatt on July 19, 1990. That claim states:

> A computer on a chip comprising:
>
> an integrated circuit chip having a computer implemented thereon;
>
> an integrated circuit main memory storing computer instructions, wherein said integrated circuit main memory is included on said integrated circuit chip;
>
> an integrated circuit operand memory storing operands, wherein said integrated circuit operand memory is included on said integrated circuit chip; and

> an integrated circuit processing circuit processing the operands stored by said integrated circuit operand memory in response to the instructions stored by said integrated circuit main memory, wherein said processing circuit is included on said integrated circuit chip.

Pet. App. 3a.

Shortly after issuance of the '516 patent, Boone provoked an interference proceeding by copying this claim into his patent application, Application No. 07/473,541 (the '541 application). *Id.* In the interference proceeding both parties claimed they were entitled to priority for the invention based upon earlier-filed patent applications pursuant to 35 U.S.C. § 120. On March 27, 1991, a Declaration of Interference was issued by the Board, according Boone an effective filing date of July 19, 1971 and Hyatt an effective filing date of December 14, 1977. Pet. App. 24a. Hyatt then moved to be accorded benefit of an earlier patent application he filed on December 28, 1970, Application No. 05/101,881. Pet. App. 25a.

Hyatt's 1970 patent application concerned a *multiple chip* "data processing system," described as follows in the "Summary of the Invention" section of the application:

> A general purpose data processor is provided which is fully implementable with integrated circuits. Thus, an integrated circuit in read-only memory (ROM) provides an example of a capacity not found in present data processing systems. Other examples are a random access memory (RAM) and other types of flip flop memories used alone or in combinations of integrated circuit memories for this data processing system.

(A206)[1] According to the 1970 patent application, a basic concept of the invention was to provide a "physically distributed, operatively dispersed system." (A212, A215-16) Thus, Hyatt's 1970 patent application described a

[1] "A" refers to the Appendix filed in the Court of Appeals.

computer system made up of *multiple* integrated circuits mounted on *multiple* printed circuit boards:

> The data processor is built from series SN7400 integrated circuits manufactured by Texas Instuments, Inc., which are located on a series of printed circuit boards. These printed circuit boards plug into a Mother board which provides necessary interconnections between the terminals of the printed circuit boards.

(A234) The application illustrated the invention with schematic diagrams of 12 different printed circuit boards on which the various chips were mounted (A207-08; A331-45) and provided a detailed description of these boards in a section entitled "Schematic Diagrams." (A280-88)

The main embodiment of the computer described in the body of Hyatt's 1970 patent application used a magnetic core memory to store data and computer instructions (A214; A326 (Figure 1)), although the application mentioned alternative embodiments in which the core memory was replaced with various types of integrated circuit memory. (A210) Thus, the application noted that the computer could be built entirely of integrated circuits:

> The architecture of the data processor 12 lends itself to a fully integrated circuit computer mainframe where all of the logic is implemented with integrated circuits in a conventional manner and additionally includes an integrated circuit scratch pad memory (SPM). Further, this data processor has the architecture to use an integrated circuit read-only memory (ROM) in place of or in addition to the core memory 30 providing a data processor that is construed wholly of integrated circuit components.

(A234)

Significantly, all the computer embodiments described in the body of Hyatt's 1970 patent application consisted of *multiple* integrated circuits mounted on *multiple* printed circuit boards. Nowhere did the body of this application

mention placing all the functions of a computer on a single integrated circuit chip. In view of these exclusively multiple-chip embodiments, one worker in the field in 1970 (Stanford University Professor of Electrical Engineering Michael J. Flynn) testified in the interference that the application described what was then a conventional minicomputer. (A1566-68)

In view of the multi-chip character of the description in the body of Hyatt's 1970 patent application, Hyatt's argument below—that the application described a complete computer on a *single chip*—was based exclusively on claim 40 of the application, as originally filed:

> 40. An electronic data processing system including read only memory means, alterable memory means and program means, said system being implemented on a single integrated circuit chip.

Pet. App. 6a.[2] Significantly, however, Hyatt testified in the interference that he had neither the experience nor the knowledge, and thus could not possibly have disclosed in his 1970 patent application, how to build a single-chip computer. Rather, "[his] plan had always been to take [his] single chip computer design to a company that built custom integrated circuits and let that company build [his] computer using one of their standard processes selected by them." Pet. App. 36a.

Hence, the factual question presented by Hyatt in the court and agency below was whether claim 40 of Hyatt's 1970 patent application sufficiently described the computer-on-a-chip invention defined in the interference such that Hyatt's far more specific and detailed 1990 patent should be deemed to have an effective filing date of December 28, 1970.

---

[2] All of the "workings of a data processing system" described by Hyatt (Pet. 7-8), were multi-chip embodiments that, as will be discussed below, the Board ruled could not properly be combined with the single-chip device described in claim 40 of Hyatt's 1970 '881 application.

2. *The Statutory Framework*

Under 35 U.S.C. § 120, a patent applicant may obtain the benefit of a prior patent application under certain circumstances:

> An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application filed in the United States . . . by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

35 U.S.C. § 120.

Thus, by the express terms of Section 120, an application must comply with the first paragraph of 35 U.S.C. § 112, which states:

> The specification shall contain a written description *of the invention,* and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112, ¶ 1 (emphasis added). The Federal Circuit, and its predecessor the CCPA, have consistently held that this paragraph contains three separate requirements for the specification. *First,* the patent must contain a written description "of the invention" such that the applicant conveys "with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention.* The invention is, for purposes of the 'written description' inquiry, *whatever is now*

claimed." *Vas-Cath, Inc. v. Mahurkar,* 935 F.2d 1555, 1563 (Fed. Cir. 1991) (emphasis added); *see also Lockwood v. American Airlines,* 107 F.3d 1565, 1572 (Fed. Cir. 1997); *In re Alton,* 76 F.3d 1168, 1172 (Fed. Cir. 1996). *Second,* the written description must not only show possession of the "invention"; it must also disclose " 'the manner and process of making and using it, in such full, clear, concise, and exact terms as to *enable* any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.' " To fulfill this enablement requirement, "a patent must give persons of ordinary skill in the relevant art enough information to practice the invention disclosed in the specification without undue experimentation." *Alton,* 76 F.3d at 1172 & n.5 (emphasis added); *see Vas-Cath,* 935 F.2d at 1563. *Third,* the written description must " 'set forth the best mode contemplated by the inventor of carrying out his invention.' " *See Alton,* 76 F.3d at 1172 & n.5 (noting that "[t]he best mode requirement mandates that the inventor disclose the best mode known to him or her at the time the patent application is filed"). Only the first two of these three requirements—"written description" and "enablement"—are relevant to this case.

3. *The 1988 Federal Circuit Decision*

On December 14, 1977, apparently cognizant that supporting any claim to a single-chip computer would require language in his patent application that would link its body's description of the circuitry of multi-chip computers with the idea of implementation on a single chip, Hyatt filed Continuation-In-Part Application No. 05/860,253. Hyatt's 1977 application *added* for the first time the linking language italicized below to that of his 1970 application:

> The basic architecture of this data processor will permit an integrated circuit memory, such as a read-only memory (ROM), or a random-access memory (RAM) or flip-flop type memory to be substituted

> for the core memory 30 to provide a completely integrated circuit computer which might be called a monolithic computer. *This monolithic data processor can be implemented on a single integrated circuit chip which can include a read only memory, an alterable memory, and program execution circuitry on the same chip.*

(A3625); *compare* A3625 (1977 application) *with* A210 (1970 application).

With his 1977 application, Hyatt presented various claims directed to a single-chip computer based on his 1970 application, which were rejected. (A3500-10; A3513-34) Although the patent examiner was dubious that claim 40 of the 1970 application disclosed a single-chip computer at all (A3562), he chose instead to focus in his Answer on his assertion that Hyatt's application did not *enable* the making of a single-chip computer as of the filing date of Hyatt's 1970 application. (A3538-39) The Board affirmed the examiner's rejections on that basis. (A3564-75)

Hyatt appealed the Board's decision to the Federal Circuit. Hyatt's patent claims involved in that appeal claimed the same invention as involved in this case, albeit with minor variations in language.[3] After reviewing the evidence relied on by Hyatt and the Board concerning the enablement issue,[4] the Court held that Hyatt had failed to establish that his 1970 application was enabling for a single-chip computer—the exact issue in the present case:

> Appellant has not come close to presenting sufficient evidence to make a persuasive case that a routineer in the integrated circuit art in 1970, presented with appellant's disclosure and supplementing it with what was well known in the art, could have implemented

---

[3] *Compare* A3953-68 (claims on appeal in 1988) *with* Pet. App. 3a (claim at issue here).

[4] *See, e.g.*, A3844-59; A3901-10; A3925-41.

> appellant's computer on a single chip without undue experimentation.

In re Hyatt, No. 87-1597 (Fed. Cir. June 9, 1988) at 9 (A1260). *See also* Pet. App. 40a. Accordingly, the Court affirmed the rejection.

In subsequent prosecution of a continuation application, Hyatt obtained allowance by the PTO of essentially the same claims by submitting essentially the same evidence of enablement, augmented by his own declaration that he believed a single-chip computer could have been built in 1970. (A3987-93; A3972-76; A3996-4006) Even so, before the Board in the present case, Hyatt himself stated that the Federal Circuit's 1988 enablement decision "can now be considered to be law of the case herein and this can be considered to be res judicata herein." Pet. App. 41a (quotation omitted).

4. *The Board's Decision in the Present Case*

With regard to Hyatt's 1970 patent application at issue here, Hyatt did not argue that no written description was required, but instead, urged that his 1970 patent application met that standard. Hyatt argued to the Board that the single-chip electronic data processing system described in claim 40 should be combined with the multi-chip embodiments described in the body of his application. The Board, however, rejected this argument, instead making factual findings that the single-chip system of claim 40 did not possess the attributes required by claim 29 of the 1990 '516 patent. *First*, the Board found that claim 40's "read only memory means" did not necessarily constitute the "main memory storing computer instructions" required by claim 29. Pet. App. 33a. *Second*, the Board found that claim 40's "alternate memory means" did not necessarily constitute the "operand memory storing operands" required by claim 29. Pet. App. 33a. *Third*, and perhaps most importantly, the Board found that claim 40's "program means" *is not* the "processing circuit" required by

claim 29, nor does it process operands in response to stored instructions. Pet. App. 33a-34a. The Board emphasized that the 1970 application's distinct use of the terms "program" and "program means" elsewhere in its specification "*makes it clear that the 'program means' is not a processing circuit.*" Pet. App. 34a (emphasis added).[5] The Board also focused upon the testimony of certain witnesses, concluding that "if 'program means' can be a circuit (processor) that responds to a program as indicated by the above witnesses, it is *at least as likely* that it can be a memory that merely stores a program without processing operands." Pet. App. 34a (emphasis added). Accordingly, the Board held that "Hyatt's [1970] '881 application fails to meet the written description requirement of 35 U.S.C. § 112, first paragraph, and . . . Hyatt is not entitled to benefits of either of [his] prior applications for that reason." Pet. App. 33a.

5. ***The Federal Circuit's Decision Below***

On appeal, the Federal Circuit affirmed the Board's decision, holding that "[t]he Board did not clearly err" in ruling that Hyatt was entitled the benefit of the filing date of his 1970 '881 application. Pet. App 5a-11a. In doing so, the court painstakingly analyzed the factual findings of the Board. The court noted that, as the Board had found, except for claim 40, "[t]here is no other mention in the '881 [1970] specification of a single integrated circuit chip, although other electronic data systems are extensively described." Pet. App. 6a. The court of appeals emphasized the Board's factual finding "that the parts of the written description that are lacking from claim 40 are not provided elsewhere in the '881 specification whose systems and circuitry neither describe nor suggest a computer on a single chip." Pet. App. 7a. The court also

---

[5] Consequently, petitioner is entirely incorrect when he states that "[t]he Board in this case did not dispute that the written description in the [1970] application could have *included* the invention in issue." Pet. 27 n.21.

carefully analyzed and affirmed the Board's findings that claim 40's (1) "read only memory means," (2) "alterable memory means" and (3) "program means" did not correspond to the requisite language in claim 29 of Hyatt's 1990 '516 patent. Pet. App. 6a-7a.

The court did not, however, address the argument Hyatt now urges upon this Court—that Section 112, paragraph 1 contains no separate and independent "written description" and "enablement" requirements. There was good reason for the Federal Circuit not to have addressed that argument: it was not raised by Hyatt either in the Federal Circuit or before the Board. To be sure, the Court of Appeals did find that the Board had applied the correct standard for its analysis—that the specification must "necessarily" describe the entire subject matter of the claim. Pet. App. 8a-9a (citing *Martin v. Mayer,* 823 F.2d 500, 505 (Fed. Cir. 1987); *Lockwood v. American Airlines, Inc.,* 107 F.3d at 1571-72; *Jepson v. Coleman,* 314 F.2d 533, 536 (CCPA 1963)). The court addressed and rejected Hyatt's argument that other Federal Circuit cases articulated a more lenient standard of "reasonably conveys," rather than "necessarily possesses," the invention, finding that regardless of the words used to describe the applicable test, "[w]e do not view these various expressions as setting divergent standards for compliance with § 112. In all cases, the purpose of the description requirement is 'to ensure that the inventor had possession as of the filing date of the application relied on, of the specific subject matter later claimed by him.'" Pet. App. 10a (quoting *In re Edwards,* 568 F.2d 1349, 1351-52 (CCPA 1978)).

The Federal Circuit concluded:

> The Board did not clearly err in finding that Hyatt did not establish in the [1970] '881 application's written description that he possessed the entire subject matter of the count. This finding comports with the criterion not only of *whether the description conveyed to the artisan the specific subject matter of the*

> *count*, but also of whether the applicant established that this was the necessary construction of that description. The written description must include the limitations of the count with sufficient clarity and specificity that "persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations."

Pet. App. 10a-11a (quoting *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976)) (emphasis added).[6]

REASONS FOR DENYING THE WRIT

Petitioner has shown no basis for review. The question presented by the petition was never raised in or ruled upon by the Federal Circuit below or any other tribunal in this case. The Court of Appeal's decision was instead based upon its agreement with the Board that petitioner had failed to establish his case *as a matter of fact*.

In sustaining the factual basis for the Board's ruling, the Federal Circuit concluded that the Board had applied the correct legal standards for its analysis. Those standards, seriously misconstrued by petitioner, are demonstrably based upon the plain text of the statute (35 U.S.C. § 112, ¶ 1). Petitioner alleges no conflict in authority, and in fact, the legal standards applied by the Federal Circuit in this case have been consistently applied by that court and its predecessor, the CCPA.

---

[6] Although presented to the Federal Circuit on Boone's cross-appeal, *see* Brief for Cross-Appellant Gary W. Boone, Nos. 96-1514, 1515 (Fed. Cir., filed Dec. 24, 1996) at 26-39, the court did not address the alternative argument that Hyatt's 1970 application was invalid based upon the collateral estoppel effect of the Federal Circuit's previous (1988) ruling that the same claims at issue here ran afoul of the "enablement" requirement of Section 112. The Board did address this issue, but did not reach a consensus regarding its proper resolution, with each of the three Administrative Judges writing and analyzing this issue separately. Pet. App. 40a-50a.

Finally, and in any event, this case would provide a particularly poor vehicle for this Court's review. For one, the Federal Circuit's ruling was dependent upon the facts found by the Board, which, as the Federal Circuit has noted in other cases under Section 112, ¶ 1, causes such cases to have limited precedential value. For another, this case is further complicated by the fact that the record discloses an alternative ground for affirmance, presented to the court below but not reached. Certiorari should be denied.

I. THE QUESTION PRESENTED BY PETITIONER WAS NOT RAISED OR RULED UPON BELOW

Petitioner seeks review of the following question: "Whether Section 112, ¶ 1 requires a patent applicant to submit a written description of his invention that, *in addition to enabling one skilled in the art to make and use the invention,* 'necessarily' shows 'possession' of the invention." Pet. (i) (emphasis added). This question—which focuses upon whether Section 112, ¶ 1 has *separate* "written description" and "enablement" requirements (*see* Pet. 11-27 (arguing entirely for the elimination of such separate requirements))—was not raised before, presented to or ruled upon by the Federal Circuit below or any other tribunal in this case. Indeed, petitioner's own statement of the issues in the Federal Circuit urged that an "express description" requirement was "proper," although disputing the content of that requirement. *See* Brief for Appellant Gilbert P. Hyatt, Nos. 96-1514, 1515 (Fed. Cir., filed Nov. 4, 1996) at 1, Resp. App. 15a-16a; *see also* Gilbert Hyatt's Petition For Rehearing and Suggestion for Rehearing In Banc, Nos. 96-1514, 1515 (Fed. Cir., filed July 15, 1998) at 1-14, Resp. App. 1a-14a; Reply Brief for Appellant Gilbert P. Hyatt, Nos. 96-1514, 1515 (Fed. Cir., filed Feb. 19, 1997).[7]

---

[7] The questions presented in the Court of Appeals were:

[1.] Whether the Board committed reversible error in denying Hyatt benefit of the '881 application by deciding that the

This Court routinely refuses to review such questions not raised below. *See, e.g., Delta Airlines v. August*, 450

---

application failed under 35 U.S.C. § 112 to describe a "computer on a chip" as defined by the Count.

A. Whether the Board committed reversible error by looking *only* at original Claim 40, failing to consider the *whole* '881 application.

B. Whether the Board committed reversible error by improperly applying the "necessary" test for an inherent description *instead of the proper "reasonably conveys" test for an express description.*

[2.] Whether the Board committed reversible error in giving Boone benefit of his 1971 application in view of at least two breaks in his chain of priority applications.

Resp. App. 15a-16a (emphasis added). Hyatt's Petition for Rehearing and Suggestion of Rehearing In Banc likewise urged the adoption of a *lesser* "reasonably conveys" test for the written description, Resp. App. 1a-14a; at no time, though, did petitioner ever advocate the *elimination* of that requirement.

In any event, the Federal Circuit's rejection of petitioner's argument below was correct since that court "d[id] not view these various expressions" such as "reasonably conveys" and "necessarily discloses" "as setting divergent standards for compliance with § 112." Pet. App. 10a. And even were there a difference, the "necessarily discloses" standard would more aptly state the proper scope of limitation upon the "written description" requirement, for to insure that the "inventor had possession, as of the filing date," "the written description must include all of the limitations of the interference count, or the applicant must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed." Pet. App. 10a. Further, the "necessarily discloses" standard would be more precise than an amorphous "reasonably conveys" standard. *See Lockwood*, 107 F.3d at 1565 (disclosure requiring "speculat[ion] as to modifications that the inventor might have envisioned, but failed to disclose" is insufficient under § 112). Finally, contrary to petitioner's unsupported suggestion, Pet. 20-21, the "necessarily discloses" standard would not work "to resolve all doubts against the inventor." Rather, the reality would be that as long as the inventor, expert in his or her own field, would fully and accurately describe the invention, the disclosure would likely be found sufficient. "The primary consideration is factual and depends

U.S. 346, 362 (1981) (refusing to consider question "presented in defendant's petition for certiorari" because "that question was not raised in the Court of Appeals and is not properly before us"). *See also Sisson v. Ruby*, 497 U.S. 358, 359 n.1 (1990); *United States v. Mendenhall*, 446 U.S. 544, 551 n.5 (1980); *Youakim v. Miller*, 425 U.S. 231, 234 (1976); *Adikes v. S.H. Kress & Co.*, 398 U.S. 144, 147 n.2 (1970). Indeed, this salutary rule carries particular force in patent cases decided by the Court of Appeals for the Federal Circuit. That court was, of course, chartered "as an exclusive appellate court for patent cases," *Markman v. Westview Instr., Inc.*, 517 U.S. 370, 390 (1996), and one of the principal reasons for concentrating patent appeals in a single court was to "provid[e] a new forum for the *definitive adjudication* of selected categories of cases," including, of course, patent cases. S. Rep. No. 275, 97th Cong., 1st Sess. 3 (1981) (emphasis added). If there were any merit to petitioner's claim that a patent application need not include a written description disclosing the intervenor's possession of the invention (which there is not), the Board and ultimately the Federal Circuit should have been given the first opportunity to address the question, in light of that court's exclusive appellate jurisdiction over, and proven expertise in, issues of patent law.

It would be strange indeed—and certainly not a useful allocation of this Court's scarce resources—to have this Court decide, as a matter of first impression in this case, the question presented by petitioner. Indeed, where—as here—the factual record developed in the agency is complicated and voluminous but highly relevant to the legal issues, it is all the more critical to have those legal issues ventilated and developed in the lower courts. The task of assessing factual agency records lies in the courts of ap-

---

on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure." *In re Wertheim*, 541 F.2d at 262.

peals in all but the rarest of instances. *See, e.g., Mobil Oil Corp. v. FPC,* 417 U.S. 283, 310 (1974); *Universal Camera Corp. v. NLRB,* 340 U.S. 474, 491 (1951).

II. THE DECISION BELOW CONFLICTS WITH NO OTHER CIRCUIT OR SUPREME COURT AUTHORITY AND WAS CORRECT

A. No Conflict In Authority Has Been Shown Or Even Alleged

As with most cases that come to this Court from the Federal Circuit, there is no conflict in authority alleged, nor could there be. Rather, petitioner's basis for invoking this Court's certiorari jurisdiction rests entirely upon the supposed "importance" (Pet. 13) of the issue presented. Notwithstanding petitioners' substantial efforts to claim that the issue presented is critical to the continuing health of the patent system, there is in fact no reason to believe that this is the case. *First,* this allegedly important issue was not sufficiently important for petitioner to have raised it in his appellate briefs or on rehearing. *See* Section I, *supra. Second,* not a single judge of the Federal Circuit viewed this case, or the issues actually decided by the Federal Circuit in this case, as sufficiently important to merit rehearing or rehearing *in banc. See* Pet. App. 20a-21a. By sharp contrast, in the handful of patent cases that this Court *has* recently accepted on review from the Federal Circuit, the Federal Cicuit has itself recognized the importance of the case either by accepting the case and deciding it *in banc,* or by addressing a conflict, not present here, between its prior decisions and settled pre-Federal Circuit precedent.[8] *See also* Section III, *infra.*

---

[8] *See Lehman v. Zurko,* 119 S. Ct. 401 (1998) (granting certiorari to review Federal Circuit's *in banc* determination of the proper standard of appellate review for factual findings made by the PTO); *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.,* 117 S. Ct. 1040 (1997) (reviewing Federal Circuit's *in banc* determination of the continued validity and contours of the judicially created

B. The Decision Below Was Correct

The Federal Circuit, and before its creation, the Court of Customs and Patent Appeals have consistently applied separate "written description" and "enablement" requirements for complying with Section 112, ¶ 1. *See, e.g., Alton,* 76 F.3d at 1172 (noting that "[t]he adequate written description requirement . . . is distinct from the enablement and best mode requirements"); *Vas-Cath,* 935 F.2d at 1560-64 (analyzing the textual basis for, history and purpose of the separate written description requirement).[9] The written description requirement is grounded in the language of Section 112, ¶ 1 that there be a "written description *of the invention.*" *See, e.g., Alton,* 76 F.3d at 1172; *Vas-Cath,* 935 F.2d at 1560; *In re Ruschig,* 379

---

doctrine of equivalents); *Markman,* 517 U.S. at 370 (reviewing Federal Circuit's *in banc* determination of whether patent claim construction is an issue of law subject to judicial resolution, or an issue of fact for jury evaluation); *Pfaff v. Wells Electronics, Inc.,* 119 S. Ct. 304, 308 (1998) (reviewing Federal Circuit's "totality of the circumstances" test for evaluating applicability of the "on-sale bar," 35 U.S.C. § 102(b), primarily "[b]ecause other courts have held or assumed that an invention cannot be 'on sale' within the meaning of § 102(b) unless and until it has been reduced to practice" (citing two pre-Federal Circuit cases from regional circuits—*Timely Products Corp. v. Arron,* 523 F.2d 288, 299-302 (2d Cir. 1975), and *Dart Industries, Inc. v. E.I. du Pont de Nemours & Co.,* 489 F.2d 1359, 1365 n.11 (7th Cir. 1973), *cert. denied,* 417 U.S. 933 (1974)).

[9] *See also In re Wilder,* 736 F.2d 1516, 1520 (Fed. Cir. 1984) (explaining that "[t]he description requirement is found in 35 U.S.C. § 112 and is separate from the enablement requirement of that provision"), *cert. denied,* 469 U.S. 1209 (1985); *In re Smith,* 481 F.2d 910, 914 (CCPA 1973) (stating that "[t]his court has repeatedly recognized a separate description requirement in the first paragraph of § 112"); *In re DiLeone,* 436 F.2d 1404, 1405 (CCPA 1971) (noting that "it is possible for a specification to enable the practice of an invention as broadly as it is claimed, and still not describe that invention"); *In re Ruschig,* 379 F.2d 990, 995-96 (CCPA 1967) (distinguishing enablement from a "written description *of the invention*").

F.2d 990, 995-96 (CCPA 1967). The purpose of this requirement is "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *Alton*, 76 F.2d at 1172 (quotation omitted). " 'Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the prima facie date of invention can fairly be held to be the filing date of the application.' " *Vas-Cath*, 935 F.2d at 1562 (quoting *In re Smith*, 481 F.2d 910, 914 (CCPA 1973)). Petitioner makes a number of unavailing attacks upon this distinct "written description" requirement.

1. A major theme of petitioner's critique of the "written description" requirement is that it is unnecessary because the enablement requirement, standing alone, ought to suffice to insure that the inventor had adequately described and demonstrated possession of his invention. *See, e.g.*, Pet. 17-18. Petitioner, however, misconstrues one of the most important reasons for the written-description requirement—the need to show that an invention (*i.e.*, something distinct from the prior art) is disclosed in the application—that would not be accomplished by an enablement requirement standing alone. As petitioner recognizes (Pet. 17 & n.13) a patent specification is comprised primarily of the written description (including any drawings) and the claims. Petitioner, though, mistakenly advocates, *id.*, that the function of distinguishing an invention from the prior art is completely fulfilled by "the language of the claims." This assertion is simply wrong, and importantly so. "[I]t is not the normal function of a claim to disclose the invention, but to point out the features of novelty in the invention *as disclosed in the specification and drawing of the application.*" *Bocciarelli v. Huffman*, 232 F.2d 647, 651 (CCPA 1956) (emphasis added). If (as petitioner advocates here) a patent application is to serve as proof

of prior invention, then the patent application as filed, not claims added years later, must provide a written description of something that differs from, and represents an advance over, the prior art. "When the scope of a claim has been changed by amendment in such a way as to justify an assertion that it is directed to a *different invention* than was the original claim, it is proper to inquire whether the newly claimed subject matter was *described* in the patent application when filed as the *invention* of the applicant." *In re Wright*, 866 F.2d 422, 424 (Fed. Cir. 1989) (emphasis added).

Indeed, historically, a major function of the written-description requirement has been to "distinguish [the invention] *from all other things before known.*" Patent Act of 1793, § 3, 1 Stat. 318; *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 434 (1822); that function continues under the present Patent Act. *See, e.g., Wright*, 866 F.2d at 424 (under the "written description" requirement, "[t]he specification as originally filed must convey clearly to those skilled in the art the information that the applicant has *invented* the specific subject matter later claimed.") (quotation omitted, emphasis added). Enablement, by contrast, can be demonstrated without showing anything different from the prior art. A patent may be enabling without disclosing "what is well known in the art." *E.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987). To be enabling for purposes of 35 U.S.C. § 112, ¶ 1, a patent can merely rely on information "well known in the art" that allows others to "make and use" the invention. Indeed, that is what Hyatt seeks to do here, admitting that he lacked the knowledge to build a single-chip computer himself, intending instead to rely on the knowledge of a "company that built custom integrated circuits." Pet. App. 36a. Without a separate requirement that Hyatt's 1970 application describe his later-claimed "invention" with sufficient clarity to show that he possessed an idea dif-

ferent from what came before, Hyatt would be conferred 1970 priority based on a patent application that disclosed nothing new.[10]

2. Petitioner also suggests (Pet. 16) that the text of 35 U.S.C. § 112, ¶ 1 does not support separate "written description" and "enablement" requirements. But Section 112, ¶ 1 specifically requires written description both "of the invention *and* of the manner and process of making and using it." (Emphasis added.) Furthermore, it is only the latter description requirement—"of the manner and process of *making and using* it" that must satisfy the additional prerequisite that it be "in such full, clear, concise, and exact terms as to *enable* [a skilled artisan] to *make and use* the same." Under petitioner's contrary interpretation, the paragraph would read:

> The specification shall contain a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same . . . .

But such a reading would "render superfluous the requirement that the specification contain a written description—'of the manner and process of making and using it [the invention],'" for "if there were a description enabling

---

[10] Petitioner seeks to make much of the fact that the Federal Circuit has used the phrase "possession of the invention" to refer to what was invented, and urges that the language of "possession" does not encompass distinction of the prior art. Pet. 17. However, the concept of "possession" of the invention has always encompassed such a distinction. As this Court held in *Evans*, the language of the 1793 Patent Act, mandating that the "written description" "distinguish [the invention] from all other things before known," was meant "to put the public *in possession of* what the party claims as *his own invention*, so as to ascertain if he claims anything that is in common use or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented" 20 U.S. at 434 (quoted in *Vas-Cath*, 935 F.2d at 1561) (emphasis added).

'any person skilled in the art . . . to make and use,' there would be no need to require a description of the 'manner and process of making and using.'" *In re Barker*, 559 F.2d 588, 591 (CCPA 1977), *cert. denied*, 434 U.S. 1064 (1978). Thus, petitioner's reading is contrary to the well-settled principle of statutory construction that "it is presumed that Congress did not use superfluous words." *Id.* at 592 (citing *United States v. Menasche*, 348 U.S. 528, 538-39 (1955)).[11]

3. At most turns, petitioner also attempts to shoehorn his case into the reasoning of this Court's recent decision in *Pfaff v. Wells Electronics, Inc.*, 119 S. Ct. 304 (1998). Pet. 2, 12-13, 17-18, 25-26. Petitioner's efforts to force-fit his newly raised question presented into the rubric of *Pfaff* is unavailing. This Court held in *Pfaff* that the "on-sale bar"—contained in a different section of the Patent Act, 35 U.S.C. § 102(b)—applies to an invention that is both the subject of a commercial offer for sale and "ready for patenting." This Court in *Pfaff* explained that this latter, ready-for-patenting condition "*may* be satisfied" by "proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention," even if not disclosed in the patent application, "that were sufficiently specific to enable a person skilled in the art to practice the invention." *Id.* at 311-12.

Plaff is inapposite for at least two fundamental reasons. *First*, contrary to petitioner's intimation (Pet. 2), the written-description requirement has nothing to do with whether an invention is "ready for patenting" in the physical sense. Rather, the written-description requirement addresses whether an invention, admittedly "ready for patenting,"

---

[11] The "written description" requirement's textual basis and long history of consistent application also make it very different from the "reduction-to-practice" and "substantial completion" standards rejected in *Pfaff*. Those rejected standards had no textual bases and were inconsistently applied by the courts of appeals.

was sufficiently described in a prior patent application so that the public would know how the invention is different from (and advances) the prior art. The "on-sale bar" rule at issue in *Pfaff* does not concern itself with distinctions over prior art, or disclosing those distinctions to the public, but concerns primarily whether the inventor is permitted to exploit his invention before patenting. *See* 119 S. Ct. at 310.[12] *Second,* whether or not the "ready for patenting standard" is synonymous with the "enablement" requirement—and the Court's use of the permissive standard of "may be satisfied" by enabling drawings or descriptions suggests that it is not—the purpose of requiring a written description of an "invention" advancing the prior art, absent from both the enablement requirement and the "ready for patenting" standard, renders *Pfaff* wholly inapplicable to the written-description requirement of 35 U.S.C. § 112, ¶ 1.

4. Finally, petitioner argues (Pet. 22-25) that the written-description requirement discriminates against amended claims in contravention of Congress's wishes. This contention is without merit for three reasons. *First,* while inventors are permitted to amend their claims, where that amendment process converts the original matter into a "*different invention,*" it is both logical and "proper" to determine whether the "newly claimed subject matter was *described*" in the original application. *Wright,* 866 F.2d at 424. *Second,* the concept that an amended claim must be so described predates substantially the drafting of Section 112 and must have been known by its draftsmen. "[T]he law is well settled that one who extracts claims from an issued patent must show clear prior disclosure." *Brand v. Thomas,* 96 F.2d 301, 303 (CCPA 1938). *Third,*

---

[12] Indeed, the information that demonstrates an invention is "ready for patenting" under *Pfaff* would not, by definition, be contained in any patent application. In contrast, the information relevant for the written-description requirement must be contained within the specification of a patent application. 35 U.S.C. § 112, ¶ 1.

contrary to petitioners' suggestion, since Section 120 was amended in 1984, *see* 35 U.S.C.A. § 120, Historical Notes (West Supp. 1998), and Section 112 was amended in 1975, *see* 35 U.S.C.A. § 112, Historical Notes (West 1984), both well after the consistent application of the written-description requirement—even according to petitioner's faulty timetable—this Court's presumption is that Congress approved of the Federal Circuit's prevailing interpretations of those sections. *See, e.g., Lindahl v. OPM*, 470 U.S. 768, 782-83 & n.15 (1985) ("Congress is presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it reenacts a statute without change") (citing *Albemarle Paper Co. v. Moody*, 422 U.S. 405, 414 n.8 (1975)).

In sum, the Federal Circuit's reading of 35 U.S.C. § 112, ¶ 1 as containing separate written-description requirements for both the "invention" and "the enablement thereof" is entirely correct and does not merit this Court's review.

III. THIS CASE PRESENTS NO ISSUE WORTHY OF THIS COURT'S CONSIDERATION

For several reasons, this case presents no issue worthy of this Court's consideration.

First. As do most interference proceedings, this case involved substantial, dispositive factual findings by the Board, which were in turn bottomed upon a voluminous record (nearly 27,000 pages) of patent applications, prosecution histories, documentary evidence and testimony. Under the well-settled precedent of both the Court of Appeals for the Federal Circuit and its predecessor, the CCPA,[13] Board decisions applying the § 112, ¶ 1 standards are reviewed under the deferential "clearly erroneous" standard. Pet. App. 5a (citing *Vas-Cath*, 935 F.2d at

---

[13] Pet. App. 7a-8a; *see also, e.g., Lockwood v. American Airlines, Inc.*, 107 F.3d at 1571-72; *Martin v. Mayer*, 823 F.2d at 505.

1563).[14] As a consequence of this deferential review, and in recognition that each interference turns on its precise facts, the Federal Circuit has noted that " 'the precedential value of cases in this area is extremely limited.' " *Vas-Cath*, 935 F.2d at 1562 (quoting *In re Driscoll*, 562 F.2d 1245, 1250 (CCPA 1977)); *see also Wertheim*, 541 F.2d at 262 ("[t]he primary consideration is *factual*").[15] So too, any decision that this Court could possibly render would have very limited precedential significance. In such circumstances, this Court has expressed reluctance to grant review. *See, e.g., First Options of Chicago, Inc. v. Kaplan*, 514 U.S. 938, 949 (1995) (emphasizing that a "fact-bound issue" was beyond the scope of questions Court agreed to review); *Smith v. Allwright*, 321 U.S. 649, 669 (1944) (Roberts, J., dissenting) (the Court should not review cases that are in "the same class as a restricted railroad ticket, good for this day and train only").

Second. Despite petitioner's efforts to show that "[t]he issues in this case are of substantial importance to the proper administration of the Patent Act" (Pet. 25; *see generally* Pet. 25-27), the supposed "obstacles," "repercussions" and "burdens" (Pet. 26) that are said to follow from the decision below are at best speculative and hypothetical ones. As noted above at p. 16, neither petitioner

---

[14] Indeed, the pending case of *Lehman v. Zurko*, 119 S. Ct. 401 (granting certiorari) presents the question of whether Board findings should be reviewed under an even more deferential standard than "clear error" (such as "arbitrary and capricious" or "substantial evidence"). A departure from the present "clearly erroneous" review in that case would only serve to make the present case even less worthy of certiorari than it already is.

[15] And, indeed, in this case, the Board's findings—for example, its finding that the 1970 application's distinct use of the terms "program" and "program means" elsewhere in its specification "*makes it clear that the 'program means' is not a processing circuit*," and thus that claim 40 of that application does not disclose a single chip computer, Pet. App. 33a-34a—are not challenged as clearly erroneous and thus demonstrate that the Federal Circuit's decision is correct, regardless of the legal standard applied.

nor any judge of the Federal Circuit thought that this issue was sufficiently important to merit presentation to or consideration by the *in banc* Federal Circuit. Additionally, because the question presented here was not briefed or argued below, there was no evidence presented below, or presented in the petition (aside from lawyer argument) that the Federal Circuit's rule—which has been the prevailing rule, without departure, for at least thirty-five years[16] and probably longer—has caused any problems for patent applicants, the PTO, or any others with an interest in the patent system. Even were there such problems, the Court should at the very least await a case in which such showings can be developed in the record and addressed by the Federal Circuit.

Third. In all events, review of the present case would be complicated by the alternative collateral estoppel ground for affirmance of the Board's decision, which divided the Board, Pet. App. 40a-44a (Urynowicz, J.); *id.* at 45a (Pate, J.); *id.* at 45a-50a (Lee, J.), but was not reached by the Federal Circuit in view of its holding on the merits of the enablement issue. In its 1988 decision in *In re Hyatt*, No. 87-1597 (Fed. Cir. June 9, 1988) (A1252-62), the Federal Circuit ruled that Hyatt's 1970 application—the same one involved here—did not enable patent claims that were virtually identical to those at issue here. As the Federal Circuit held in *Amgen Inc. v. Genetics Institute, Inc.*, 98 F.3d 1328, 1332 (Fed. Cir. 1996), in cases where "the same issue of enablement arises as was decided in [a prior proceeding]," relitigation is prohibited by the doctrine of issue preclusion, even though the patent claims in the two proceedings may have minor differences. In view of these rulings, petitioner would not be able to show that his 1970 application was enabling and, regardless of the outcome of his challenge to the no-written-description holding of the Federal Circuit, the Board's denial of benefit would have to be affirmed on the alternative ground of

---

[16] *See Jepson v. Coleman*, 314 F.2d at 536.

non-enablement. Even were all of the other requisites for certiorari present—which they are not—the Court should certainly prefer a vehicle for resolution of this issue that is not complicated by issues of preclusion.

CONCLUSION

For the foregoing reasons, the petition should be denied.

Respectfully submitted,

Of Counsel:
JAY M. CANTOR
Suite 300 East
1100 New York Avenue, N.W.
Washington, D.C. 20005-3955
(202) 414-4048

LOUIS TOUTON *
JONES, DAY, REAVIS & POGUE
555 West Fifth Street
Los Angeles, CA 90013-1025
(213) 489-3939

GREGORY A. CASTANIAS
JONES, DAY, REAVIS & POGUE
1450 G Street, N.W.
Washington, D.C. 20005
(202) 879-3939
Counsel for Respondent

* Counsel of Record

December 1998

APPENDIX

APPENDIX

[Filed July 15, 1998]

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Appeal Nos. 95-1514, -1515

GILBERT P. HYATT,
Appellant,

-v.-

GARY W. BOONE,
Cross-Appellant.

Appeal from a Decision of the
Board of Patent Appeals and Interferences
dated September 19, 1995 and May 10, 1996

GILBERT P. HYATT'S PETITION FOR
REHEARING AND SUGGESTION FOR
REHEARING IN BANC

* * * *

INTRODUCTION

This is an appeal from a decision of the United States Patent and Trademark Office, Board of Patent Appeals and Interferences (the "Board"). The appeal involves a patent interference between (1) U.S. Patent No. 4,942,516, entitled "Single Chip Integrated Circuit Com-

puter Architecture," issued to Gilbert P. Hyatt ("Hyatt") and claiming priority to original patent application Serial No. 101,881 (the "'881 application") and (2) patent application Serial No. 473,541, entitled "Variable Function Programmed Systems" by Gary W. Boone ("Boone"). The primary issue on appeal is whether the '881 application provides a written description of a computer having two memories and a processing circuit implemented on a single integrated circuit chip as defined by the sole Count-in-interference (the "Count").

POINTS OF FACT AND LAW OVERLOOKED OR MISAPPREHENDED BY THE PANEL

As detailed in Hyatt's opening and reply briefs, it is *undisputed* that the body of the '881 application expressly describes an electronic data processing system—a computer—having two memories and a processing circuit that operate as required by the Court. It is also *undisputed* that the body of the application describes the data processing system implemented as a completely integrated circuit or "monolithic" computer, and that a monolithic computer is a computer implemented on one or more chips. It is thus *undisputed* that the body of the '881 application expressly describes all the limitations of the Count except for the specific words "single integrated circuit chip." However, it is also *undisputed* that original Claim 40 of the '881 application expressly describes an "electronic data processing system . . . implemented on a single integrated circuit chip." Since an original claim is to be read on what is disclosed in the application and not as a different embodiment, *Bocciarelli v. Huffman*, 232 F.2d 647, 651, 109 USPQ 385, 388 (C.C.P.A. 1956), the description of a monolithic computer in the body of the application must be read together with original Claim 40. Together they provide a complete, express description of the Count.

Simply put, the body of the '881 application expressly describes the computer defined by the Count and original

Claim 40 complements that description by expressly describing implementation of *the disclosed computer* on a single integrated circuit chip. As a result, the '881 application provides a complete written description of the Count—it "reasonably conveys" to those skilled in the art that Hyatt was in possession of the invention defined by the Count.

In deciding this appeal, the Panel ignored the body of the '881 application on the mistaken belief that it did not describe or suggest a single chip computer. It then decided that original Claim 40 *alone* did not "necessarily" provide a written description of the Count. The Panel failed to consider claim 40 in conjunction with the monolithic computer—a computer implemented on one or more chips—even though it is undisputed that claim 40 reads on the previously described monolithic computer and expressly describes implementation on a single chip. The Panel looked only at original Claim 40, despite the requirement to consider the application "as a whole." *See, e.g., In re Wright*, 866 F.2d 422, 425, 9 USPQ 2d 1649, 1651 (Fed. Cir. 1989) (application must be considered "as a whole" to decide compliance with 35 U.S.C. § 112, ¶ 1).

Accordingly, Hyatt submits this petition for rehearing because the Panel overlooked or misapprehended the express teaching in the body of the '881 application of a completely integrated circuit or monolithic computer.

ISSUE OF LAW NECESSITATING CONSIDERATION OF THE FULL COURT TO MAINTAIN UNIFORMITY OF ITS DECISIONS

Prior precedent of this Court has held that the proper test for determining compliance with the written description requirement of 35 U.S.C. § 112 ¶ 1 when dealing with an express diclosure is whether an application "reasonably conveys" possession of the invention. *See, e.g., Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1115-16 (Fed. Cir. 1991). Prior prece-

dent has also developed a stricter "necessary and only" test for meeting the written description requirement when an inventor needs to rely on an *inherent* feature not expressly described within his application. *See, e.g., Kennecott Corp. v. Kyocera Int'l Inc.*, 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987), *cert. denied*, 486 U.S. 1008 (1988) (hereinafter "*Kennecott*"). *See also In re Daniels*, No. 97-1225, 1998 WL 257309 at *2, 46 USPQ2d 1788 (Fed. Cir. May 20, 1998) (necessary test used when a disclosure is "less than clear on its face . . .")

The Panel in the present case recognized that this Court's precedent has used the two phrases "reasonably conveys" and "necessary and only" in deciding written description issues. (Decision, p. 9.) However, the Panel held that those two distinct phrases were not "divergent standards for compliance with § 112." (Decision, p. 9-10.) As a result, the Panel established a new precedent—it merged the standard for express disclosure into the standard for inherent disclosure and phrased the merged standard as a "necessarily comprehended" test for written description. (Decision, p. 10.) The Panel then applied its "necessarily comprehended" test to decide that the '881 application did not provide a written description of the Count. (Decision, p. 10.)

The Panel's "necessarily comprehended" test applied to an express written description is in direct conflict with prior precedent of this Court. Moreover, by applying its overly-strict "necessarily comprehended" test, the Panel reached the wrong result—finding that the '881 application did not provide a written description of the Count. Accordingly, Hyatt suggests that the present appeal be reheard in banc to allow this Court to maintain uniformity with its prior decisions concerning the written description requirement of 35 U.S.C. § 112, ¶ 1.

ARGUMENT

A. The Panel Overlooked or Misapprehended the Fact That the Body of the '881 Application Describes A Completely Integrated Circuit or Monolithic Computer

When a panel overlooks or misapprehends an essential fact or rule of law, rehearing of the appeal is appropriate, Fed. Cir. R. 40; *See, e.g., Frederick v. Department of Justice*, No. 95-3194, 1996 WL 293120, *1 (Fed. Cir. May 22, 1996). That has happened here.

Central to the Panel's decision that the '881 application did not provide a written description of the Count was its erroneous findings (i) that other than original Claim 40, there is no description or suggestion in the body of the application of a computer implemented on a single integrated circuit chip and (ii) that the Board made a similar finding. As stated by the Panel:

> *There is no other mention in the '881 application of a single integrated circuit chip*, although other electronic data processing systems are extensively described.
>
> * * *
>
> *The Board found* that the parts of the written description that are lacking from Claim 40 are not provided elsewere in the '881 specification, whose systems and circuitry neither describe nor suggest a computer on a single chip.

Decision, pp. 6-7 (Emphasis added).

The Panel then looked only at original Claim 40 without reference to the body of the application and decided that Claim 40 *alone* did not describe the two memories and the single chip processing circuit of the Count.

The Panel made a fundamental and material error. The body of the '881 application *does* describe a com-

pletely integrated circuit or monolithic computer. Moreover, the Board *never* made a contrary finding.

The body of the '881 application expressly describes in detail a computer having two memories and a processing circuit that operate as recited in the Count. As clearly shown in Figs. 1 and 4 (A326), it is undisputed that the application discloses an electronic data processing system having (1) a main memory 30 for storing computer instructions (the "main memory" of the Count), (ii) an alterable scratch pad memory 110 which stores operands (the "operand memory" of the Count), and (iii) a data processor 12 which processes operands stored in the alterable scratch pad memory 110 in response to instructions stored in the main memory 30 (the "processing circuit" of the Count). For a more detailed discussion of these features see Hyatt's Main Brief, pp. 10-17.

The application also teaches that the basic design or "architecture," of its processing circuit 12 permitted the system to use an integrated circuit read only memory to create a "completely integrated circuit computer," expressly described as a "monolithic computer." (A210, lines 13-19.) The term "monolithic computer" was understood in the art as an express description or suggestion of a computer capable of being implemented on a single integrated circuit chip. (A493-95, A431-32, A1011-12.) In fact, Boone's own expert witness, Dr. Wooley, testified that the term "monolithic" described a single integrated circuit chip, or a combination of integrated circuits, i.e. one or more chips. (A 3103.) Further, Boone himself used the term "monolithic calculator" to describe his single chip calculator in the corresponding Boone application-in-interference. (*See, e.g.*, A2534, line 12.) See Hyatt's Reply Brief, pp. 6-7, for further discussion of the term monolithic.

The Panel's error in not considering the application's disclosure "as a whole", including the description of a

monolithic computer and not reading Claim 40 in conjunction with that disclosure was not harmless. *In re Wright*, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989).

It is black letter law that an original claim to an application is part of the original disclosure. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 938, 15 USPQ2d 1321, 1326 (Fed. Cir.), *cert. denied*, 498 U.S. 920 (1990); *In re Edwards*, 568 F.2d 1349, 1352, 196 USPQ 465, 468 (C.C.P.A. 1978). However, to determine what an original claim decribes for § 112 purposes, one must look at what the original claim discloses in the context of the body of the application rather than as a different embodiment. *Bocciarelli v. Huffman*, 232 F.2d 647, 651, 109 USPQ 385, 388 (C.C.P.A. 1956). Accordingly,

> if an original claim can be given a reasonable interpretation which will make it readable on what is disclosed in the specification or drawing, it is proper to adopt that interpretation rather than to seek to construe broad language in the claim as a disclosure of other embodiments.

Id. at 651, 109 USPQ at 388.

The rationale for that rule is clear. Original claims to an application are designed to broadly point out the novel features *of the invention disclosed in the original application*. In this case, Claim 40 is fully compatible with the monolithic computer disclosed in the body of the '881 application. The read only memory means of Claim 40 corresponds to the integrated circuit read only memory 30 of the monolithic computer while the alterable memory means of Claim 40 corresponds to the alterable operand memory 110 of the monolithic computer. Regardless of whether the program means of Claim 40 is interpreted to mean a program or a data processing circuit, it is consistent with the previous description of a monolithic com-

puter, which has both. Further, since Boone's own witness testified that monolithic is defined as implementation on one or more chips (A3103), the Claim 40 recitation of a single chip is also fully compatible with the monolithic computer.

It is thus clear that there are no differences that can support a conclusion that Hyatt's monolithic computer and Claim 40 represent different embodiments. *See also* Hyatt's Main Brief pp. 17-18 and Hyatt's Reply Brief pp. 5-13. Boone has not, and indeed cannot, point to a single element of Claim 40 that is incompatible with Hyatt's previously disclosed monolithic computer that is to be implemented on one or more chips. Since Claim 40 is fully consistent with the monolithic computer, the descriptions of the monolithic computer and of Claim 40 must be read together as the description of a single embodiment.

Contrary to the decision (p.6), Hyatt does *not* contend that Claim 40 by itself describes the subject matter of the inference count. Hyatt does contend, and it is *undisputed,* that the body or the application expressly describes a monolithic computer having every feature of the count implemented on one or more chips. When this undisputed description is combined with the single chip recitation of Claim 40, which reads on Hyatt's monolithic computer, the '881 application provides an express written description of every feature of the Count.

In re Ruschig, 379 F.2d 990, 154 USPQ 118 (C.C.P.A. 1967), is the first case clearly recognizing the written description requirement. 4 Chisum § 7.04[1][a][1] (1998). The court there stated:

> It is an old custom in the woods to mark trails by making blaze marks on the trees. It is no help in finding a trail or in finding one's way through the woods where the trails have disappeared—or have not yet been made. . .—to be confronted simply by

> a large number of unmarked trees. Appellants are pointing to trees. We are looking for blaze marks which single out particular trees.

In re Rushig, 379 F.2d at 994-95, 154 USPQ at 122. The detailed teaching of a completely integrated circuit or monolithic computer in the body of the '881 application, in combination with Claim 40, provides just such blaze marks to the subject matter of the Count.

B. This Appeal Should Be Heard In Banc To Maintain Uniformity With Prior Precedent On The Proper Test for the Written Description Requirement Under 35 U.S.C. § 112, ¶ 1

A rehearing in banc will be ordered when a Panel's decision is contrary to prior precedent and, as a result, consideration of the full Court is necessary to secure or maintain uniformity of its decisions or overrule its prior decisions. Fed. Cir. R. 35; *see also Cybor Corp. v. FAS Technologies, Inc.* 138 F.3d 1448, 1455-56, 46 USPQ2d 1169, 1173 (Fed. Cir. 1998) (in banc review required in order for this Court to maintain uniformity of its decisions concerning the proper standard of review for claim construction issues); *Nobelpharma AB v. Implant Innovations, Inc,,* 141 F.3d 1059, 1068 n.5, 46 USPQ2d 1097, 1104 n.5 (Fed. Cir. 1998) (in banc review required to overrule this Court's prior decisions concerning antitrust issues). Since the Panel's decison concerning the written description requirement is contrary to this Court's precedent, a rehearing in banc is warranted.

As detailed in Hyatt's opening and reply briefs, when an application expressly discloses the invention the proper test for determining compliance with the written description requirement of 35 U.S.C. § 112 is whether that disclosure "reasonably conveys" to one skilled in the art that the inventor was in possession of the later claimed invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1115-16 (Fed. Cir. 1991). The

"reasonably conveys" test has been consistently applied by this Court in deciding the issue of express written description under § 112.[1] Moreover, it has been adopted by the PTO as the proper test for review of patent applications.[2]

However, unlike the present case, when an application does not expressly describe a claim limitation but discloses a device that "inherently" has a property meeting that limitation, the inventor can rely on that inherent property to satisfy the written description requirement. *In re Reynolds*, 443 F.2d 384, 389, 170 USPQ 94, 98 (C.C.P.A. 1971). To prove the inherent property, the inventor has to meet a stricter "necessary and only" test—the inventor must show that the " 'necessary and only reasonable construction to be given the disclosure by one skilled in the art is one which will lend clear support to . . . [this] positive limitation.' " *Kennecott*, 835 F.2d at 1423, 5 USPQ2d at 1198 (quoting *Langer v. Kaufman*, 465 F.2d 915, 918, 175 USPQ 172, 174 (C.C.P.A. 1972)). The same "necessary and only" test for an inherent disclosure is also used when determining whether a prior art reference under 35 U.S.C. § 102 inherently discloses a claimed feature.[3]

---

[1] *See, e.g., Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1533, 25 USPQ2d 1241, 1245 (Fed. Cir. 1992); *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (hereinafter *"Ralston Purina"*).

[2] Manual of Patent Examining Procedure § 2163 (1996); *Request for Comments on Interim Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112 ¶ 1* (hereinafter *"Interim Guidelines"*); *"Written Description" Requirement*, 63 Fed. Reg. 32,639-45 (1998).

[3] *See, e.g., Electro Medical Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1020 (Fed. Cir. 1994) (Court applied necessary test to determine if prior art inherently anticipated claimed invention); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (same).

Very recently, this Court touched on this issue when it reiterated that the "reasonably conveys" test is used to determine compliance with the written description requirement, citing *Ralston Purina,* and the "necessary" test is used when a disclosure is "less than clear on its face," citing *Kennecott,* an inherency case. *In re Daniels,* No. 97-1225, 1998 WL 257309, at *2 (Fed. Cir. May 20, 1998).

In view of the distinct standards, this Court has held that when an application expressly describes a limitation, as in the present case, it is reversible error to apply the "necessary and only" test. Specifically, if the limitation is expressly described, it is improper to require the application to "necessarily exclude" other limitations or "necessarily include" a limitation that excludes all other possible limitations. *Vas-Cath,* 935 F.2d at 1566-67, 19 USPQ2d at 1119 (district court committed reversible error by requiring under § 112 that the original application *necessarily exclude* other limitations not claimed after expressly describing the claimed limitation).

The Panel in the present case recognized that prior precedent of this Court has used the two phrases "reasonably conveys" and "necessary and only" in deciding written description issues. (Decision, p. 9.) However, the Panel held that those two distinct phrases were not "divergent standards for compliance with § 112." (Decision, pp. 9-10.) As a result, the Panel established new precedent—it merged the standard for explicit disclosure into the standard for inherent disclosure using the phrase "necessarily comprehended." (Decision, p. 10.) The Panel then applied its strict "necessarily comprehended" test to an explict disclosure to decide that original Claim 40, standing alone and apart from its supporting disclosure, did not provide a written description of the Count. (Decision, p. 10.)

The Panel's decision is in direct conflict with the prior precedent of this Court which established the "reasonably

conveys" test as the proper test for express written description. The Panel's decision is also in conflict with the recently published *In re Daniels* decision which recognized that a distinction in the law exists.

If left standing, the Panel's decision will wrongfully deny Hyatt priority to his original application. As detailed above, there is no dispute that (1) the '881 application describes a monolithic computer having two memories and a processing circuit that operated as recited in the Count and (2) original Claim 40 describes implementing a computer on a single integrated circuit chip. Since the three elements recited in Claim 40 are all found in the monolithic computer, one skilled in the art would recognize that the computer described in original Claim 40 is the same monolithic computer that is described throughout the body of the application. To require that original Claim 40 necessarily exclude all other computers is an improper standard for complying with the written description requirement. *Vas-Cath Inc.*, 935 F.2d at 1566-67, 19 USPQ2d at 1119.

Moreover, the Panel's decision will wreak havoc in the PTO—where numerous applications are reviewed daily for compliance with the written description requirement—and in the courts whenever the written description requirement is at issue.

As applied, the Panel's "necessarily comprehended" test would require inventors to not only describe their inventions but also to expressly describe what their inventions necessarily *exclude*. That is, to expressly describe all embodiments which the inventor does *not* consider to be his invention, as was the effect of the decision in this case.

The Panel's decision also adds to the confusion in this Circuit concerning the written description requirement rather than clarifying it. For example, as discussed above, in *In re Daniels* this Court defined a second "necessary"

test that is to be applied when a disclosure is "less than clear on its face" and then cited an inherency case, *Kennecott*, as authority. In another example, *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1480, 45 USPQ2d 1498, 1503-04 (Fed. Cir. 1998), this Court decided that a disclosure of a preferred embodiment was insufficient under the written description requirement to support a claim broader than that which was expressly disclosed—a decision sharply criticized by the patent bar. *See, e.g.*, Laurence H. Pretty, *Federal Circuit Narrows the Protection of Patents Closer Toward Their Specific Disclosures*, IPL Newsletter, Vol. 16, No. 3, Spring 1998.

Finally, the PTO recently published *Interim Guidelines* setting forth its understanding of the law concerning the written description requirement under 35 USC §112, ¶ 1 and requesting comments.

In view of the Panel's improper, and case dispositive, restatement of the test for written description, recent decisions of this Court obfuscating the law on written description, and the PTO's recent request for comment, Hyatt suggests that this appeal be heard in banc to allow this Court the opportunity to maintain uniformity with its prior decisions and to clarify the law concerning the written description requirement under 35 U.S.C. § 112, ¶ 1.

CONCLUSION

For the reasons stated above, the Panel should rehear this case. If the Panel decides not to rehear this case, the Court should set this case for in banc briefing and argument.

Respectfully submitted,

/s/ Gregory L. Roth
GREGORY L. ROTH
LAW OFFICES OF GREGORY L. ROTH
6 Centerpointe Drive, Suite 780
La Palma, California 90623
(714) 521-1333

JOHN M. DIMATTEO
PATTERSON, BELKNAP, WEBB & TYLER LLP
1133 Avenue of the Americas
New York, New York 10036-6710
(212) 336-2000

JAMES T. WILLIAMS
SULLIVAN & CROMWELL
125 Broad Street
New York, New York 10004
(212) 558-4000

Attorneys for Appellant

[Filed Nov. 4, 1996]

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Appeal Nos. 96-1514, -1515

GILBERT P. HYATT,
Appellant,

v.

GARY W. BOONE,
Cross-Appellant.

Appeal from a Decision of the
Board of Patent Appeals and Interferences
dated September 19, 1995 and May 10, 1996

BRIEF FOR APPELLANT GILBERT P. HYATT

STATEMENT OF THE ISSUES

POINT I:

Whether the Board committed reversible error in denying Hyatt benefit of the '881 application by deciding that the application failed under 35 U.S.C. § 112 to describe a "computer on a chip" as defined by the Count.

A. Whether the Board committed reversible error by looking *only* at original Claim

40, failing to consider the *whole* '881 application.

B. Whether the Board committed reversible error by improperly applying the "necessary" test for an inherent description instead of the proper "reasonably conveys" test for an express description.

POINT II:

Whether the Board committed reversible error in giving Boone benefit of his 1971 application in view of at least two breaks in his chain of priority applications.